

REMARKS

FORMAL MATTERS:

Claims 22-29, 31-35, 37, 38 and 40-46 are pending after entry of the amendments set forth herein.

Claims 1-21 were previously canceled without prejudice. Claims 30, 36 and 39 are canceled with this amendment without prejudice.

Claims 22, 24-29, 31-35, 27 and 38 are amended.

New claims 40-46 have been added.

Amendment to claim 22 is to address antecedent basis only.

Amendment to claims 24-28 reformat the claims to recite limitations to the claimed method steps. The amendments import the limitations of the relevant step of the parent claim, incorporating the limitations of the prior dependent claim. No new elements are added.

Amendment to claim 29 was made according to the suggestions of the Examiner.

The amendments to claims 31-35 are formal in nature. No new matter has been added.

Claims 37 and 38 reformat prior pending claims 27 and 38 to read on computer software embodied in a computer-readable medium, and finds support in original claim 19 and page 4, line 27 to page 5, lines 23 of the original specification and in Figures 2 and 3.

New claims 40-44 find support in the original claims to the application, particularly original claim 1, and page 2, line 20 to page 4, line 12.

New claims 45 and 46 are supported at page 5, line 25.

No new matter is added.

REJECTIONS UNDER §112, ¶2

Claims 24-28, 30-39 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. Claims 24-28, 30-35, 37-39 have been amended to address the concerns expressed in the Office Action. Claim 36 has been canceled. In view of the amendments entered with this response, Applicant respectfully submits that the claims are now in condition for allowance and requests the instant rejections be withdrawn.

REJECTIONS UNDER §101

Claim 37 is rejected under 35 U.S.C. §101 because it recites a computer program code that is not embodied in a computer readable medium. In response, Applicants have amended claim 37 to recite computer software embodied in a computer readable medium. Applicants have also re-written claim 29 according to the Examiner's suggestions. In view of these amendments, Applicants respectfully request the instant rejection be withdrawn.

REJECTIONS UNDER §103(A)

Claims 22-23, 29 and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rabin (US Patent No. 6,697,948 ('948 patent)). According to the Office Action, the '948 patent discloses a processing method comprising the steps of Applicants' invention including administering a processing agent substance to a subject chosen from a human being, a plant and an animal, the processing agent having a primary behavior effective in combination with a processing system to achieve a desired process result, the processing agent further having a distinctive signature characteristic distinguishing it

from other processing agents (col. 15. lines 30-50; ...fingerprint process...). The rejection simply does not explain how it is possible to administer an image such as a fingerprint to a subject such as a human being. In accordance with applicants' invention the processing agent is administered to the subject. For example, radioisotopes are administered to the subject. See new claims 45 and 46.

The Office Action asserts that the '948 patent does not explicitly disclose that the processing subject is chosen from a human being, a plant or an animal. According to the Office Action, one skilled in the art could extend the '948 patent by analogy to cover subjects chosen in Applicant's claimed invention. Therefore, it is asserted in the Office Action that it would have been obvious to one of ordinary skill in the art to modify the method of the '948 patent by extending it to a processing subject chosen from a human being, a plant or an animal. Applicants respectively disagree.

Establishing a *prima facie* case for obviousness under §103 requires the Examiner show, *inter alia*, that the prior art reference teach or suggest all claim limitations of the rejected claim(s). *In re Royka*, 180 USPQ 580 (CCPA 1974); and MPEP §2143.03. Applicants respectfully submit that the '948 patent does not teach "...administering a processing agent substance to a subject..." as recited for Applicant's claimed invention, nor could one of skill in the art analogize the disclosure of the '948 patent to extend it to a processing subject chosen from a human being, a plant or an animal.

The '948 patent discusses a method of identifying an "untagged instance of software" installed on a device by performing a "fingerprint process" on the untagged software. "Fingerprints" are stored at a "guardian center" remote from the device running the untagged software. According to the '948 patent:

"To obtain fingerprints at the guardian center, the software vendor transmits a copy of an untagged infringing instance of software to the guardian center and the guardian center computes fingerprints on the copy of the untagged infringing instance of the software and stores the fingerprints in the fingerprint database."
Col. 15, lines 62-67.

Applicants' respectfully submit that it is evident from the '948 disclosure that the "fingerprint" is not a processing agent substance administered to a subject, as recited in Applicant's claims. The processing agent substance must be a material which is, in some way, capable of being administered to a subject such as a human. The '948 reference simply does not disclose such. Still further, the '948 patent does not disclose a processing agent substance such as the radioactive isotopes now claimed in new claims 45 and 46. Rather, the "fingerprint" of the '948 patent is computed from the untagged copy of software, in a similar manner to a checksum. Therefore, the fingerprint of the '948 patent is a number computed from the untagged software and a characteristic inherent in the untagged copy of software, not an administered processing agent. Accordingly, Applicants respectfully submit that a '948 patent "fingerprint" is not a "distinctive signature characteristic of a processing agent" as required by Applicants' claims, and can never be considered as such, because the '948 patent does not teach Applicants' claimed step of administration of a processing agent to a subject. Accordingly, the '948 patent fails to teach each limitation of Applicants' claimed invention.

The Office Action concedes that the '948 patent does not disclose application of the '948 process to a human being, a plant or an animal as recited in Applicants' claims. However, without explanation the Office Action asserts that it would have been obvious to one skilled in the art to extend the '948 patent by analogy to cover such subjects. Applicants respectfully disagree.

The '948 patent is clearly non-analogous art to Applicants' invention. Assuming that one of skill in the art would for any reason be compelled to visit the '948 patent, in addition to the arguments already presented above, the Office Action fails to explain how one of skill in the art at the time if Applicants' invention could make a copy of a human being, plant or animal in order to compute the "fingerprint" as taught by the '948 patent. Applicants respectfully submit that both copying a subject of Applicants' invention and computing a fingerprint for that copy as discussed in the '948 patent is not within the skill in the art at the time of the invention. Even if such technology did exist, as explained above, the calculated "fingerprint" of the subject would be an inherent characteristic of the subject and not a characteristic of a processing agent administered to the subject as required by Applicants claimed invention. Accordingly, Applicants respectfully submit that the proposed combination of the '948 patent and knowledge in the art fails to teach all of the elements of Applicants' claimed invention, and

the missing elements are not obvious absent knowledge of Applicants' invention and use of impermissible hindsight. Applicants respectfully request the instant rejection be withdrawn.

With regard to additional comments made in the Office Action regarding claims 23 and 29, Applicants respectfully point out those comments are moot in view of the response provided above. With regard to claim 39, that claim has been cancelled without prejudice.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number KEMP-011.

Respectfully submitted,
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Date:

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